REMARKS/ARGUMENTS

In view of the foregoing amendments and the following remarks, the applicants respectfully submit that the pending claims comply with 35 U.S.C. § 112, are not anticipated under 35 U.S.C. § 102 and are not rendered obvious under 35 U.S.C. § 103. Accordingly, it is believed that this application is in condition for allowance. **If, however, the Examiner believes that there are any unresolved issues, or believes that some or all of the claims are not in condition for allowance, <u>the applicant respectfully requests that the Examiner contact the undersigned to schedule a telephone Examiner Interview before any further actions on the merits</u>.**

The applicants will now address each of the issues raised in the outstanding Office Action.

Rejections under 35 U.S.C. § 112

Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

The Examiner contends that although claim 1 recites "determining whether or not the storage medium has been assigned a unique value label and a unique label identifier," the specification does not include an enabling disclosure of this feature. (Paper No. 142006, page 2.) The Examiner also contends that the specification did not include the term "unique label identifier". (Paper No. 142006, page 2.) The Examiner

then assumed that the process of determining a new label for a new floppy disk reads on "determining whether of not the storage medium has been assigned a unique volume label and a unique label identifier. (Paper No. 142006, page 2.) Finally, using a common dictionary, the Examiner interpreted the claimed unique volume label and the claimed unique label identifier as being interchangeable means for naming a floppy disk. (Paper No. 142006, page 2.)

The teachings of the specification, as they would be understood by one skilled in the art, as well as relevant case law, are now introduced.

MPEP § 2164.01 correctly notes that the test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent, coupled with information known in the art, without undue experimentation. One skilled in the art could determine whether or not the storage medium has been assigned a unique volume label and a unique label identifier (or a unique storage medium label) without undue experimentation in light of the teachings of the specification, the level of skill in the art, and the predictable nature of data storage.

It is assumed that those skilled in the art would have knowledge of various storage medium operations, such as reading, writing, formatting, etc. It is further assumed that such operations are predictable. As for the specification, it states, in pertinent part:

> Basically, *when files are first written to a machine-readable medium* 218, the content tracking base operation(s) 212 will, based on state

information 264, *associate a <u>unique</u> <u>identifier</u> (<u>and</u> a unique volume label) with the machine-readable medium* 218. Further, when files are first written to the machine-readable medium 218, the content tracking base operation(s) 212 will also provide <u>*unique information*</u> *to the label generation operation(s) 224 for having the printer 226 generate a <u>label</u>* (such as a bar code label for example) 228. In alternative embodiments, other types of machine-readable labels can be generated instead. [Emphasis added.]

Page 11, lines 5-16.

In the following, the term "<u>*unique volume label*</u>" uniquely identifies a storage medium, and may be *written onto the storage medium*. Therefore, if the storage medium is a diskette, the unique volume label may be a unique label written onto the diskette by a floppy disk drive, and that may be subsequently read by a floppy drive. The term "<u>*label*</u>" *also <u>uniquely identifies</u> a storage medium, but is associated with (e.g., affixed to) the storage medium.* Therefore, if the storage medium is a diskette, the label may be a bar code label affixed to the case of the diskette, and that may be subsequently read by a bar code reader. Although the unique volume label, and the label of a given storage medium may be the same, or encode the same information, this is not necessarily the case.

Referring back to conditional branch point 310, recall that *it is determined whether or not a storage medium is new. This may be done, for example, by comparing the unique volume label, if any, of the storage medium, with stored state information* (Recall,

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e.g., 264 of Figure 2.). *If the storage medium is determined to be new, the method 212' continues to block 315 where a unique label and a unique volume label are determined.* For example, these labels may be determined from state information 264, such as a counter that is incremented for each new storage medium for example. Then, as indicated by blocks 320 and 325, the unique volume label is written onto the storage medium, and a command to print (or otherwise generate) a unique label associated with the storage medium is generated. Referring back to Figure 2, this command may be passed to the label generation operation 224. The user may then associate the printed unique label with the storage medium (e.g., by affixing it to a so-called "jewel-box" case or cartridge used to hold the storage medium). Alternatively, the unique label may be automatically associated with the storage medium (i.e., without (further) user intervention) in another way. As indicated by block 330, the database may be updated to reflect saved or deleted files. For example, this may be done by adding a new record (or item), or by altering an appropriate existing record (or item), when a file is saved, or by removing an appropriate record (or item) when a file is deleted. The key of the record (or item) may correspond to that used for the unique label, or the unique volume label, though this is not necessarily true. As indicated by optional block 335, a synchronization may be effected (Recall, e.g., operations 262 and 258 of Figure 2.) if possible. The method 212' may then be left via RETURN node 360.

Referring back to conditional branch point 310, if the storage medium

is determined not to be new, the method
212' continues to block 330, which was
just described above.

Naturally, there are many
ways to assign unique volume labels.
One exemplary way is to maintain a
sequence count which may be initialized
(e.g., to "1000") when the content
tracking application is installed onto
the read/write machine (e.g., a
personal computer). The unique volume
label may be written by launching a DOS
command such as "label a: {sequence
count value}" within a JAVA
application. When determining whether
a current disk has a valid unique
volume label, the (unique) volume label
can be read and compared with the
sequence count. If the read (unique)
volume label is greater than the value
of the sequence count (or less than the
value of the initial sequence count),
or is not an x-digit (e.g., 4-digit)
number, then it may be deemed invalid.

Page 17, line 10 through page 19, line 14.

Assigning and tracking one or more unique
identifiers for each of a plurality of storage mediums is
certainly practicable by those skilled in the art. More
specifically, as can be appreciated from the foregoing
excerpts, the first time files are written to a storage
medium, a "unique volume label" might be written onto the
storage medium and a "label" might be associated with
(e.g., affixed to) the storage medium. The "label" is
obviously generated from some data. The applicants chose
to call this a "unique label identifier". (MPEP §
2173.01 correctly notes that applicants are their own
lexicographers and may use functional language,
alternative expressions, negative limitations, or any

style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought.)

Since both the unique label identifier and unique volume label are determined when the storage medium has not been assigned a unique volume label and a unique label identifier, the absence of either or both of these from a storage medium can be used to indicate the storage medium has not been assigned a unique volume label and a unique label identifier. Since determining whether or not a storage medium includes a volume label can be accomplished by those skilled in the art, it follows logically that those skilled in the art can determine whether or not the storage medium has not been assigned a unique volume label and a unique label identifier. Consequently, the rejection under 35 U.S.C. § 112, paragraph 1 is improper and should be withdrawn.

Although the applicants may use any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought, claims 1 and 20 have been amended to replace "unique label identifier" with "unique storage medium label". As can be appreciated from the foregoing excerpts, the unique storage medium label uniquely identifies the storage medium.

As can be appreciated from the foregoing, claim 1 is enabled. Consequently, the applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection of claim 1, as well as of dependent claims 2-14.

Rejections under 35 U.S.C. § 102

Claims 1-8, 10-15, 19-27, 29-35 and 39-42 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,483,602 ("the Haneda patent"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Before addressing at least some of the patentable features of these claims, the Haneda patent is first introduced. The Haneda patent concerns a film image management system. Referring to Figure 10 of the Haneda patent, undeveloped film is developed and read, and image information is saved to a laboratory disk, printed, and recorded (perhaps in reduced form) on a user disk. Labels with an identification code may be printed and affixed to one or both of a film roll container or envelope, and the user disk. (See, e.g., Figures 3-7.)

In addition to, or instead of, affixing the bar code label to the disk, the identification code may be stored on the disk. Examples of the identification code are listed on column 15, lines 14-48. The label may be provided with human comprehensible characters, symbols, and/or figures. (See, e.g., Figures 8 and 9.)

Note that the media contents of the developed film, to which an identification code label is applied, are fixed. Similarly, the media contents of the user disk, to which an identification code label is applied, are intended to be fixed.

The identification code and frame identifiers may be used when ordering extra prints (e.g., via a communications network or via a paper order form). For

example, such extra prints may be ordered while the user is viewing the images using a playback program. Specifically, the laboratory can use the identification code and frame identifier to retrieve images that the user wants extra prints of. (See, e.g., column 5, lines 29-42.)

Having introduced the Haneda patent above, at least some patentable features of the claims are now discussed.

Claims 1-8, 10-14, 20-27, 29-34, 40, 41 and 43

Independent claims 1 and 20 are not anticipated by the Haneda patent because the Haneda patent does not teach an act of (or means for) determining whether or not the storage medium has been assigned a unique volume label and a unique storage medium label (the unique storage medium label uniquely identifying the storage medium), and if the storage medium has not been assigned a unique volume label and a unique storage medium label, then determining *both* a unique storage medium label for the storage medium, *and* a unique volume label for the storage medium, writing the unique volume label onto the storage medium, and providing a command to generate a label based on the unique storage medium label, the label to be associated with the storage medium.

In the rejection of claims 1-14 under 35 U.S.C. § 112, first paragraph, the Examiner noted that he would:

> assume the process of determining a new
> label for a new floppy disk reads on
> "determining whether or not the storage
> medium has been assigned a unique

volume label and a unique label
identifier."

Paper No. 142006, page 2. In the rejection of these
claims as being anticipated under the Haneda patent, the
Examiner cites column 4, lines 8-15, which describes
storing an identification code on film, a user recording
medium, and a laboratory recording medium as teaching
this feature. (See Paper No. 142006, page 3.)

The applicants respectfully, but strongly submit
that the Examiner is improperly ignoring features of the
claimed invention which distinguish it over the Haneda
patent. Specifically, merely affixing or storing an
identification code to a storage medium does not teach
determining whether or not the storage medium has been
assigned a unique volume label and a unique storage
medium label (the unique storage medium label uniquely
identifying the storage medium). As discussed above, in
the Haneda patent, undeveloped film is developed and
read, and image information is saved to a laboratory
disk, printed, and recorded (perhaps in reduced form) on
a user disk. Labels with an identification code may be
printed and affixed to one or both of a film roll
container or envelope, and the user disk. Note that the
media contents of the developed film to which an
identification code label are fixed. Similarly, the
media contents of the user disk to which an
identification code label are intended to be fixed. That
is, the user disk is intended to be written with reduced
or original sized images, and perhaps the identification
code, once. Consequently, there would be no need to
determine whether or not this has been written on the

user disk -- when the laboratory first stores the image data on the user disk, such information has not already been written and/or applied to the disk.

Independent claims 1 and 20 are not anticipated by the Haneda patent for at least the foregoing reason. Since claim 2-8, 10-14 and 40 depend, either directly or indirectly, from claim 1, and since claims 21-27, 29-34 and 41 depend, either directly or indirectly, from claim 20, these claims are similarly not anticipated by the Haneda patent.

Dependent claim 13 further recites that accepted information read from a label associated with the storage medium is read by a handheld device, and the information about accepted records (accepted in response to a request from a database instance using a database key converted from the accepted information) is rendered on the handheld device. The Examiner cited paragraph 39 of the Haneda patent as teaching this feature. (See Paper No. 142006, page 6.) However, the applicants have not found this feature in the Haneda patent. If this ground of rejection is maintained, the applicants respectfully request that the Examiner cite the column and line numbers and/or Figure and reference numbers of the Haneda patent alleged to teach this feature.

Claims 15, 19, 35, 39 and 42

Independent claims 15 and 35, as amended, are not anticipated by the Haneda patent because the Haneda patent does not teach an act of (or means for) accepting one or more search parameters selected from a group of parameters consisting of (A) file name, (B) file size, (C)

file author, and (D) file type. The Examiner apparently is interpreting the frame numbers in the Haneda patent as the claimed search parameters. (See Paper No. 142006, page 6.) However, these claims, as amended, recite specific types of search parameters which distinguish the claimed invention over even the Examiner's interpretation of the Haneda patent. Accordingly, independent claims 15 and 35 are not anticipated by the Haneda patent. Since claims 19 and 42 depend from claim 15, and since claim 39 depends from claim 35, these claims are similarly not anticipated by the Haneda patent.

Rejections under 35 U.S.C. § 103

Claims 9 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Haneda patent in view of U.S. Patent No. 4,864,616 ("the Pond patent"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Since the purported teachings of the Pond patent fail to compensate for the deficiencies of the Haneda patent with respect to claims 1 and 20 as discussed above, even assuming, arguendo, that one skilled in the art would have been motivated to combine the Haneda and Pond references as proposed by the Examiner, such a combination would fail to render the invention of claims 1 and 20, and therefore of claims 9 and 28, unpatentable.

Claims 16-18 and 36-38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Haneda patent in view of U.S. Patent No. 5,971,279 ("the

Raistrick patent"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Since the purported teachings of the Raistrick patent fail to compensate for the deficiencies of the Haneda patent with respect to claims 15 and 35 as discussed above, even assuming, arguendo, that one skilled in the art would have been motivated to combine the Haneda and Raistrick patents as proposed by the Examiner, such a combination would fail to render the invention of claims 15 and 35, and therefore of claims 16-18 and 36-38, unpatentable.

Claim 43 stands rejected under 35 U.S.C. § 103 as being unpatentable over the Haneda patent. The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

The Examiner takes official notice that updating a database based on files deleted from a storage medium is well-known and that implementing this into the Haneda patent would have been obvious to those skilled in the art. The Examiner's motivation to combine the purported well-known database update is that it would make searching simpler by eliminating from the database directory, files that have been deleted. (See Paper No. 142006, page 11.)

First, even assuming, arguendo, that updating a database based on files deleted from a storage medium is well-known, and further assuming, arguendo, that one skilled in the art would have been motivated to combine this purported knowledge into the Haneda patent as

proposed by the Examiner, claim 1 would still not be rendered obvious for the reasons discussed above. Since claim 43 depends from claim 1, it would similarly be non-obvious.

Second, even assuming, arguendo, that updating a database based on files deleted from a storage medium is well-known, the Haneda patent does not contemplate changing the image data written to the user disk. That is, it is not contemplated that the user will delete such image data from the user disk. Moreover, the laboratory storage is apparently intended to be an archival storage (and is not provided with both a unique volume label and a unique storage medium label, the unique storage medium label uniquely identifying the storage medium), and consequently, image file deletion from laboratory storage is also not contemplated. Accordingly, there would be no motivation to combine the purportedly well-known act of updating a database based on files deleted from a storage medium into the system described in the Haneda patent. Accordingly, claim 43 is not rendered obvious by the Haneda patent for at least this additional reason.

Conclusion

In view of the foregoing amendments and remarks, the applicants respectfully submit that the pending claims are in condition for allowance. Accordingly, the applicants request that the Examiner pass this application to issue.

Respectfully submitted,

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CERTIFICATE OF MAILING under 37 C.F.R. 1.8(a)

I hereby certify that this correspondence is being deposited on **June 6, 2006** with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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